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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/865,445	05/29/2001	Yoshitaka Sasaki	104241.01	4644

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EXAMINER

NGUYEN, TAI V

ART UNIT	PAPER NUMBER
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3729

DATE MAILED: 02/10/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/865,445

Applicant(s)

SASAKI ET AL.

Examiner

Tai Van Nguyen

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-- **Th MAILING DATE of this communication app ars on the cover sheet with the correspondence address --**
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3 and 4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 09/391,232.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

R sponds to Amendment

1. The applicants' amendment filed 12/04/2003 (paper No. 11) has been considered and made of record.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 3 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakanishi et al (US 4,226,018).

As applied to claim 3, Nakanishi et al discloses a method of manufacturing a thin film magnetic head material, the head material including: a plurality of rows of head-to-be sections to be thin film magnetic heads; an inter-row cutting section provide to be position between adjacent ones of the rows that are to be separated; and an intra-row cutting section provided to be a position between adjacent ones of the head-to-be sections in each of rows that are to be separated; the method including the steps of: providing a detection element (8) to be used for detecting an amount of processing when specific processing is performed on the head material (1a, Fig. 2); an electrode (5) for electrically connecting the detection element to an external device; and a conductor (6) for electrically connecting the electrode to the detection element; and forming the electrode in the inter-row cutting section (A, Fig. 1).

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As applied to claim 4, Nakanishi et al discloses the detection element and the conductor are formed in the intra-row cutting section (B, Fig. 1).

Response to Arguments

4. Applicant's arguments filed 12/04/2003 have been fully considered but they are not persuasive.

The applicants contends that Nakanishi et al does not teach, 1) "an inter-row cutting section provided to be a position between adjacent ones of rows that are to be separated and an intra-row cutting section provided to be a portion between adjacent ones of the head to be section in each of the rows that are to be separated".

The examiner traverses for the following reasons:

First, whether the materials are separated or not is irrelevant because the claims never recite any separation or cutting. In other words, there are no active steps recited in the claims directed to separating or cutting and it appears that the applicants are arguing more specifically than that which is claimed.

Secondly, the limitation of "inter-row cutting section" is very broad and the regions between the cut lines A (shown in Fig. 1) are read as "inter-row cutting section". The electrode 5 is formed in this region or "inter-row cutting section" (line 11 of claim 3).

Accordingly, Nakanishi et al fully satisfies all of the limitations of claims 3 and 4 and maintains the rejection above.

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tai Van Nguyen whose telephone number is 703-308-1791. The examiner can normally be reached on M-F (7:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 703-308-1789. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tn.
February 6, 2004.



**A. DEXTER TUGBANG
PRIMARY EXAMINER**